



ATTACHMENT A

Remarks

Before considering the new rejection of the claims, it is noted that the claims have been amended in a number of instances to address the issues raised in the "Response to Arguments."

For example, the Examiner has pointed out that, in his judgment, the claim "user" in the "instant claims is broad enough to read on an operator at a CATV headend or server choosing or determining the scheduled time and channel of a transmission of EPG data." The claims have been amended to recite that the user is "a user of a receiver for receiving in-band data broadcast in a channel."

The Examiner has also "noted that 'EPG data' is broader than an EPG, since EPG 'data' reads on any portion of an EPG, such as the title, broadcast time, channel etc. of a movie, whereas the EPG is the overall guide." The Examiner has stated that this "distinction is pointed out since the claim is still broad enough to read on a user requesting to receive a movie for scheduling downloading and storage, such that the transmitted movie includes its title, station name or number, and/or broadcast time, etc, or some other EPG data, wherein the EPG data may be transmitted as associated data, for instance" (emphasis in the original). To address this issue, the claims have been amended to refer to an EPG rather than EPG data.

The Examiner has also stated that "[a]s for the claimed scheduled time, it is pointed that the 'scheduled time' is broad enough to read on the user scheduling to receive the EP data 'right now' or immediately upon demand. 'Scheduled time' is not limited to a broadcast time in the future." In order to address this point, the phrase "scheduled time" has been amended to refer to "a scheduled broadcast time in the future."

The final point raised in the "Response to Arguments" is dealt with below.

Turning to the specific rejections on prior art, claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35, 36, 39 and 45-51 were rejected under 35 U.S.C. § 103(a) as being "unpatentable over" Schultheiss (U.S. Patent No. 6,208,384) in view of Schein (U.S. Patent No. 6,247,176), Ohga (U.S. Patent No. 5,465,385), and Marsh (U.S. Patent No. 6,208,799). This rejection is respectfully traversed.

First, it is noted that four different references have been relied on as teaching various aspects of the invention. It is respectfully submitted that while the various references may broadly teach the feature that they are relied on as teaching, the proposed combination of references is the improper product of hindsight.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103(a) is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d USPQ 698 (Fed. Cir. 1983); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. Further, hindsight must be avoided, i.e., the disclosed structure should not be used as a “template” and elements simply selected from the references to reconstruct the claimed invention. In re Gorman, 993 F.2d 982, 987, 18 USPQ 2d (BNA) 1885, 1888 (Fed. Cir. 1991). The use of four references in the rejections of each grouping of claims is highly suggestive that the disclosed structure is being used as a template and individual elements are being taken from each reference in a hindsight reconstruction of Applicant’s claimed invention. Further, the use of individual elements from four references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

Considering the latter point in more detail, and taking one example, the Examiner agrees that the Schultheiss and Schein patents do not disclose the use of the scheduling process for “powering on the tuning circuit” but states that “Ohga (column 5, lines 5-10) teaches when a present time clock corresponds to the start time of a user desired broadcast, at that time the ‘CPU 25 automatically turns on the power of the TV receiver 3’, which reads on the claimed process ... operable for powering on a timer circuitry’.” (emphasis in the original). Claim 1, is directed to a system wherein, inter alia, a caching process is operable for determining if a scheduling conflict exists and “for determining whether tuning circuitry has been powered-on and, if not, powering-on the tuning circuitry if no scheduling conflict exists.” This is clearly something different from simply powering-on tuner circuitry when a particular clock time occurs as in Ohga. Further, this is also different from detecting whether the TV is on. Moreover, not only do

the Schultheiss and Schein patent fail to teach this powering-on feature, they fail to teach the “scheduling conflict” feature.

Of course, the Examiner contends that the “scheduling conflict” feature is taught by Marsh. The Marsh patent determines “if a conflict exists between the usable IPG data item that is stored within new IPG data 51 to the IPG data that is recorded in all other active VCR-record-timers 27” and if yes, generates “a user-alert message for current-time or for future-time viewing by the set-top user.” There is obviously no interaction here with the powering-on of tuning circuitry and, again, given the actual teachings of the four different references that are being combined to meet the terms of the claims, it is respectfully submitted that the combination is necessarily based on considering whether specific individual differences are obvious and not on whether the invention as a whole is obvious.

As pointed out previously, claim 1 also recites “a user initiated scheduling process operable to provide an interface for a user to determine a scheduled broadcast time in the future and channel for an electronic program guide in an in-band data broadcast, and for invoking the real-time scheduling process to schedule execution of a caching process at approximately the scheduled time.” The Examiner appears to admit that Schultheiss does not disclose that the user interface further enables the user to determine a scheduled broadcast time in the future and channel of the EPG, and attempts to make up for this deficiency of Schultheiss by asserting that Schein, at column 6, lines 21-40, discloses the recited feature. As is believed clear from the cited section, Schein merely teaches that a user may select one of several instances of a schedule for a show. The Schein system will then cause a VCR to record the show at the scheduled time. The Examiner has pointed to lines 43-48 of column 6. However, these lines simply refer to providing information as to other sources of the show or information about the show (e.g., similar to that shown in Fig. 3). This is different from the invention as claimed, in which the EPG, not a show or information related to a single show, is cached at a scheduled time. Thus, it is respectfully submitted that claim 1 defines over the references cited for this reason as well.

Turning to dependent claims 2-6, these are, of course, allowable for at least the same reasons as discussed above with respect to claim 1.

In addition, claim 2 recites retrieving the scheduled time and channel from a source while claim 3 recites that the source is an in-band data broadcast. In other words, as claimed in these claims, the schedule of EPG transmissions is itself obtained from a source. It is asserted in the Office Action that the recited language reads on the combination of Schultheiss and Schein, but the Office Action fails to identify any structure in Schultheiss or Schein that serves as a schedule of EPG transmissions (i.e., a schedule for a transmission of a schedule of programs). Thus, it is respectfully requested that the rejection of claims 2 and 3 be withdrawn.

Claim 9 has been rejected for the same reasons as claim 1. It is respectfully submitted that the arguments above with respect to claim 1 also apply to claim 9. The Office Action further states that the “user is enabled to choose to receive EPG data broadcasts.” It is noted that Schultheiss does not teach or disclose that the user can choose a scheduled broadcast time in the future for receiving the EPG, rather EPG data appears to be received in response to the user’s request. It is respectfully submitted that receiving a response to a request is different from scheduling a time for receiving EPG data. For the above reasons, it is respectfully requested that the rejection of claim 9 be withdrawn.

Claims 10-13 depend from claim 9 and are, therefore, allowable for the same reasons as discussed above with respect to claim 9.

Further, claim 10, as amended, recites “displaying a plurality of schedules of a different content to a user for selection,” while claim 18, as amended, recites “the scheduled time and the channel are selected by a user of the digital processing system from a plurality of data service schedules of different content.” The Office Action asserts that Fig. 3 of Schein teaches the features claimed. However, rather than a plurality of schedules, Fig. 3 of Schein appears to be a display of a single schedule of multiple broadcasts of the show “Gone with the Wind.” This is different from a plurality of schedules of different content, so that whatever the merit of the argument advanced with respect to claims 10 and 19 as previously presented, it is clear neither Schein nor the other cited references teach or disclose each and every element of claims 10 and 18, particularly as amended. Thus withdrawal of the rejection of claims 10 and 18 is respectfully solicited.

Claims 11, 12, 19 and 22 recite similar language to that of claims 2 and 3. It is respectfully submitted that claims 11, 12, 19 and 22 are allowable for basically the same reasons as discussed above with respect to claims 2 and 3.

Claim 15 has been rejected for the same reasons as claim 9, which was rejected using the same rationale as claim 1. It is respectfully submitted that claim 15 is allowable basically for the same reasons as discussed above with respect to claims 1 and 9.

Claims 16, 21 and 25 have been rejected for the same reasons as claim 1. It is respectfully submitted that the arguments set forth above with respect to claim 1 apply as well to claims 16, 21 and 25 and it is respectfully requested that the rejection of claims 16, 21 and 25 be withdrawn. Further, claim 25 specifically recites that the scheduled information is "non-audio and non-video information." It is noted that Schein teaches the scheduling of shows, which are at least video and most likely include audio information. As a result, Schein does not teach the scheduled receipt of non-audio and non-video information as claimed.

Claims 17-19 depend from claim 16, claims 22-23 depend from claim 21, and claims 28-31 depend from claim 25 and are therefore allowable for at least the same reasons as their respective base claims 16, 21 and, 25 respectively, which, in turn, are allowable for basically the same reasons as discussed above with respect to claim 1.

In addition, claim 29 has been rejected because the features of the claim are asserted to be met by the combination of Schultheiss and Schein. However, no supporting details have been provided in the rejection. It is respectfully submitted that claim 29 is allowable for at least the same reasons as discussed above with respect to claim 1.

Claim 32 has been rejected for the same reasons as claim 9. It is respectfully submitted that claim 32 is allowable for the same reasons as discussed above with respect to claim 9 (and also claim 1).

Claim 35 depends from claim 32 and is, therefore, patentable for at least the same reasons as claim 32.

Claim 36 has been rejected using the same rationale as claim 1. It is respectfully submitted that claim 36 is patentable for the same reasons as discussed above with respect to claim 1.

Claim 39 depends from claim 36, and is therefore, patentable for at least the same reasons as parent claim 36 and thus as base claim 1.

Claim 45 recites that the real time scheduling process schedules “multiple executions of the caching process.” It is asserted in the Office Action that the recited language is broad enough to read on Schultheiss and Schein, since “the user is enabled to choose and execute multiple broadcast programs.” Applicant respectfully disagrees with this interpretation of the cited references. The cited references may allow a user to select recording of multiple programs, however, this is not a teaching of the execution of multiple caching processes. No structure corresponding to multiple caching processes has been identified and thus it is respectfully requested that the rejection of claim 45 be withdrawn.

With respect to claims 46-51, the Office Action asserts that because Schein teaches requesting information from the Internet, that it would be obvious to one of ordinary skill in the art at the time the invention was made to provide a subscriber any other additional type of data. Applicant respectfully disagrees and traverses the rejection. As indicated above, Schein merely teaches that a show and information about a show can be obtained over the Internet. Schein does not teach the scheduled reception of information such as stock quotes and sports access.

Additionally, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. In re Sang Su Lee, 277 mF.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action states that the motivation to combine Schultheiss and Schein is “providing the subscriber with a wider range of information.” It is respectfully submitted that given the actual teachings of the references, the cited motivation to combine is not found in the references themselves. The cited references do not state that their purpose or benefit is to provide a wider range of information and it is respectfully submitted that the quoted

statement from the Office Action is merely a conclusory statement of belief and not specific objective evidence of a motivation to combine.

Claim 44 has been rejected under 35 U.S.C. § 103(a) as being “unpatentable over” Schultheiss, Schein, Ohga and Marsh as applied to claim 1, and further in view of Klosterman (US 5,550,576). Klosterman is not relied on as teaching, and does not teach, the subject matter of claim 1 and thus claim 44 is patentable for at least the reasons discussed above in support of the patentability of claim 1. Further, the need to combine a fifth reference to reject claim 44 is further evidence of its patentability. As discussed above with respect to claim 1, none of Schultheiss, Schein, Ohga or Marsh teach or disclose the recited language. Moreover, applicant has reviewed Klosterman and can find no teaching or disclosure of the cited language. Thus, it is respectfully requested that the rejection of claim 44 be withdrawn.

Finally, the numerous brief discussions with Examiner Brown are gratefully acknowledged. A more comprehensive telephone interview has been previously scheduled but the Examiner turned out to be unavailable at the scheduled time. Because a response is now due to be filed and an interview still has not been scheduled, Applicant has proceeded with filing an Amendment. In the Amendment, Applicant has addressed each of the points raised in the “Response to Arguments” and was presented a full response. However, if necessary, Applicant is still willing to discuss this application further with the Examiner either in a telephone interview or in a personal interview at the Patent and Trademark Office.

Allowance of the application in its present form is respectfully solicited.

END REMARKS